

REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the November 8, 2002 Office Action. In that Office Action, claims 1-3, 13, 16, 18, 21-24, 31, 33, 34, 37-39, 46 and 48 were rejected under 35 U.S.C. §102(a) as being anticipated by the www.clubphoto.com pages excised from "The Wayback Machine", with an asserted date of April 17, 1999.

Claims 4, 14, 15, 25, 32, 40 and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over the pages of the Clubphoto web-site in view of "official notices" asserted by the Examiner. Further, claims 5-12, 26-30, and 41-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over the displayed pages of the Clubphoto web-site in view of a March 3, 1998 on-line newspaper article entitled "21st Century Technology is Coming to L.I. Running", in further view of a June 30, 1993 on-line article entitled "Toll-booth torment" from USA Today. Moreover, claims 17, 19, 20, 35, 36, 49 and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over the displayed pages of the Clubphoto web-site in view of Garfinkle et al. (U.S. Patent No. 6,017,517).

In Response, Applicant has amended claims 1, 3-5, 13, 14 and 16; cancelled claims 2 and 21-50; and added new claims 51-75. Based upon these claim amendments and the following remarks, Applicant respectfully requests reexamination and reconsideration of the application.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not what the reference broadly "teaches". *Kalman v. Kimberly-Clarke Corp.*, 218 USPQ 781 (Fed. Cir. 1983). There must

be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripts Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ 2d 1001, 18 USPQ 2d 1896 (Fed. Cir. 1991).

The "Clubphoto" web-site models the typical activities of a photo studio. Photo studios typically consist of an office, a display room, an area where pictures are taken, and a storage room where pictures are kept on file. Customers typically visit the studio to have their picture taken, or photographers employed by the studio are asked to visit a customer's event, such as a wedding. Pictures are taken and then processed by the photo studio. At some point the customer is invited to visit the studio to view the pictures that were taken. The purpose of the meeting is to present a selection of pictures and make decisions which images will be purchased by the customer.

Clubphoto is modeled after the general activities of a photo studio. A customer requests photos to be taken at some event and the photographer now has a means of displaying those photographs on the Internet. The advantage of Clubphoto is that the photographer has access to a virtual photo studio by means of the Internet. Customers no longer have to visit a physical location, but rather can simply view their pictures on Clubphoto's web-site and make decisions about which photos to purchase.

The customer and photographer relationship is clearly evident on the displays of the Clubphoto web-site. "Enter the password provided by your photographer" and "Check with your event photographer" are typical phrases found on Clubphoto's web-site. Ostensibly, individuals could download personal photographs to enable relatives and the like to view them at a single site.

The typical operations of a photo studio, or the virtual photo studio provided by Clubphoto, become impractical when there is no customer who

specifically requested their photo to be taken. The process of the present invention is directed to such unsolicited event photos, such as those taken during a typical sporting event which may include marathons, triathalons, bicycle races, and the like.

The present invention, as recited in independent claim 1, resides in a process for providing event photographs for inspection, selection and distribution via a computer network. Photographs are taken of the event, which is typically a sporting event, as recited in new claims 51-75. As recited in the independent claims, identifying data is associated with each photograph taken. As recited in claims 4 and 59, the identifying data may include a number corresponding to a number worn by the event participant. Alternatively, as recited in claims 5-12 and 64-71, the identifying data may comprise a code acquired from a component worn by an event participant. Another alternative, which is preferably used in the process of the present invention, and as recited in claims 13-15 and 51-54 is to use the date and time, or estimated time, that the photograph was taken. Using such identifying data is particularly useful in the sporting event context as numbers or transmitters are often worn to correlate the runner or event participant with the finish line or the like. Also, event participants often remember the time at critical junctures of the sporting event, such as the finish line.

As further recited in the independent claims, the photographs are then transferred to a computer network server where they are cataloged in a web-site server according to the identifying data. The event participants access the server and search for a particular photograph utilizing the identifying data. The particular photograph is then displayed for inspection and can be ordered.

On its face, there are substantial differences between the claimed invention and the Clubphoto web-site as viewed by a person of ordinary skill in

the field of the invention. Independent claim 1 requires that identifying data be associated with each photograph taken. This is not the case with the Photoclub web-site. Instead, a password is provided to view an entire set of photographs taken by the photographer or provided by a relative or the like.

Claim 1 also recites the photographs are cataloged in a web-site server according to the identifying data, and that the server can be accessed and searched for a particular photograph utilizing the identifying data. Thus, a runner in a marathon, for example, who crosses the finish line at approximately 11 a.m. can find his or her particular photograph showing him or her crossing the finish line by searching the web-site of the present invention according to the 11 a.m. time of the date of the marathon. Alternatively, the runner can search the web-site by the "bib number" worn by the runner. As another alternative, the code acquired from the component worn by the event participant is used to acquire the photographs of just that participant. In contrast, those utilizing the Photoclub web-site would be required to look at each image on the Internet which was grouped under the password. For those involved in a sporting event, this would require that the particular sporting event participant look at each image on the Internet of the entire event to find their particular image. This could involve viewing hundreds or even thousands of images. This is not a viable or practical solution to provide event photographs for inspection, selection and distribution. Due to the frustration of viewing the great number of photographs, it is likely that the event participant would quickly lose patience and not order any pictures.

For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990). The Photoclub web-site does not associate identifying data with each photograph taken. Nor does the Photoclub web-site enable one to access and search for a particular

photograph utilizing the identifying data. Moreover the Photoclub web-site does not catalog the photographs according to the identifying data. Instead, a user of the Photoclub web-site must download the Living Album 99 software which can then be used to extract photos from the web-site and create personal albums, annotate the various photos, alter the photos, etc. This software must be downloaded onto each user's personal computer and the user must then learn the parameters of the software before organizing, annotating, etc. This stand-alone and separate program utilizes relational databases, which are not novel and have been in the public knowledge domain for many years. The Clubphoto Internet web-site does not provide cataloging or searching features as recited in independent claim 1.

With respect to dependent claim 13, the Photoclub web-site does not disclose utilizing date and time the photograph was taken as identifying data or a means for searching for a particular photograph. Nor does the Living Album 99 software disclose utilizing date and time.

From the foregoing, Applicant respectfully asserts that independent claim 1, as amended, and those claims depending therefrom, are not rendered obvious by the Clubphoto web-site reference. For the same reasons, new claims 51-75 are not rendered obvious by this reference either.

CLAIM REJECTION UNDER 35 U.S.C. §103

Claims 4, 14, 15, 25, 32, 40 and 47 were rejected as being obvious over the Clubphoto web-site and various "official notices" provided by the Examiner. The Office Action properly admitted that the Clubphoto web-site does not disclose that data be used to aid participants in finding their desired photos, including a number corresponding to a number worn by an event participant. Nor does Clubphoto disclose that an event participant can search for a particular

photograph by an approximate time, or the approximate time is calculated by an equation relating distance and time of the entire event.

The Examiner asserted that it would have been obvious to modify the Clubphoto site such that event participants could search for pictures of themselves by using their identification number in order to make photograph identification and retrieval easier. The Examiner also asserted that it would have been obvious to modify the Clubphoto web-site to allow event participants to estimate a time frame and search the photos by the estimated time frame in order to broaden their searching capabilities.

Applicant respectfully traverses such "official notices". Although it is well-known that participants of sporting events wear numbers for easy identification, there is no basis or evidence that it would have been obvious to modify the Clubphoto web-site to search for pictures by using such identification numbers. Nor is there any evidence, other than Examiner's bald assertion, to modify the Clubphoto web-site to allow event participants to search by estimated time, or to utilize an equation as recited in claims 15 and 54 to estimate the time the photograph was taken. Applicant respectfully asserts that such searching techniques and cataloging of photographs by using such identifying data is not obvious and renders these claims patentable. As such, Applicant respectfully asserts that claims 4, 13-15, and 51-58 are not obvious and patentably distinct from the prior art.

Original claims 5-12, 26-30, 41-45 were rejected as being obvious over the Clubphoto web-site in view of the "21st Century Technology is Coming to L.I. Running" article and further in view of the "Toll-booth torment" article. The Office Action correctly admits that Clubphoto does not disclose a system where photo-identifying data includes a code from a component worn by an event participant, a sensor that interfaces with the component, a passive bar code

component, an inductive circuit passive component, an active component nor a component including a transmitter. The newspaper article discloses a Champion Chip Timing System which provides faster and more accurate race results by utilizing a small plastic chip which when passed over a rubber mat at the finish line instantly identifies the chip and attaches the accurate time so that each participant has a very accurate time. The Examiner asserts that it would have been obvious to modify the Clubphoto web-site to include identification by a chip worn by an event participant in order to provide means for participant identification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

There is no discussion whatsoever in the Clubphoto web-site regarding the use of wearing components for acquiring code information to identify individuals who are being photographed. In fact, on its face, this would seem quite ludicrous as the Clubphoto web-site is directed to photographers of wedding events, and those individuals who desire to share their personal photographs with relatives and the like. In fact, as described above, other than a password or name of a party of the wedding event, there are no other

indications of identification or identifying indicia with which to associate with the photographs.

The article describing the "Champion Chip Timing System" merely discloses the use of plastic electronic chips which are used to identify an individual's finish time upon passing the chip over a rubberized mat. There is no disclosure whatsoever with respect to photographing the event participants.

Thus, Applicant respectfully asserts that these two references are completely non-analogous to one another and do not provide the teachings to render the present invention obvious.

The Examiner extends the logic of combining these two references even further by combining a third reference relating to Toll-booths and the use of credit card-size windshield tags to pass through toll booths. Once again, there would be no motivation for one skilled in the art of event photography to utilize the teachings of a toll-booth newspaper article in arriving at the present invention. The combination of the three references borders on ludicrous.

As stated by M.P.E.P. §2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the difference is themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Citing, Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 218 USPQ 698 (Fed. Cir. 1983). Further, a prior art reference must be considered in its entirety, i.e., as a whole including portions that would lead away from the claimed invention. M.P.E.P. §2141.02, *citing, W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 US 851 (1984).

Considered as a whole, the claimed invention would not have been obvious in light of these references. As stated above, prior art references must

be considered in their entirety, including portions which would lead away from the claimed invention.

The Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness, that there must be some suggestion or motivation in either the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the referenced teachings. Applicant asserts that there is no suggestion or motivation in the three references for their combination to arrive at the present invention. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 *citing In re Mills*, 16 USPQ 2d 1430 (Fed. Cir. 1990).

In fact, Applicant believes that these three references are only analogous to one another if viewed in light of the teachings of the present application, otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. *Life Technologies, Inc. v. Clontech Laboratories, Inc.*, 56 USPQ 2d 1186 (Fed. Cir. 2000).

Thus, it appears as if the Examiner has inappropriately used Applicant's claims as a framework from which to pick and choose among individual references to recreate the claimed invention. Of course, it is well-known that such hindsight is impermissible and strictly forbidden. It is also well-known that it is impermissible within the framework of 35 U.S.C. §103 to pick and choose from a reference only so much of it that will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of

what the reference fairly suggests to one skilled in the art. Bausch & Lomb v. Barnes Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986).

Lastly, the present invention solves the problem of identifying individuals who have not solicited or otherwise requested that their picture be taken at an event, and particularly a sporting event, but who might be interested in purchasing photographs or the like after the event. The present invention solves many problems, including the identification of particular photographs of this individual at the finish line or during the course of the event. The event participant, as described above, is able to visit Applicant's web-site and using the identifying data, such as that described above, search for a particular photograph of himself or herself at the event. None of the prior art references disclose of such a problem or the solution to these problems.

In the rare case where the prior art does not appreciate the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. *In re Nomiya et al.*, 184 USPQ 607, 612-613 (CCPA 1975).

From the foregoing, Applicant respectfully traverses the obviousness rejection as directed to the combination of the three references and believes that the recitations of these claims are not rendered obvious even when the references are improperly combined.

Lastly, claims 17, 19, 20, 35, 36, 49 and 50 were rejected as being unpatentable over the Clubphoto web-site in view of the Garfinkle patent. The Office Action correctly admitted that the Clubphoto web-site does not disclose providing a digital camera that immediately downloads photos from the event to a server, nor mailing or electronically transferring the photograph to the ordering event participant.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

Claims 17, 55, 60 and 72 recite the provision of a digital camera electronically connected to the server for immediate download of photographs from the event to the server. In contrast, Garfinkle discloses a system wherein consumers present their film or digital camera chip for processing which is subsequently downloaded onto a web-site so that the consumer can view such photographs and determine which photographs to have made into prints. Similar to the Photoclub web-site, relatives and the like can also view such photographs and order prints as well. Aside from lacking the teachings to overcome the shortcomings of the Photoclub reference, the Garfinkle patent does not disclose that the digital camera be electronically connected to the server for immediate download of the photographs from the event to the server. Such connection enables the photographs to be placed on the web-site of Applicant in real time to enable others to view photographs of the event as they are transpiring. Thus, for example, a spouse in California could view her husband finishing a triathlon event in Hawaii in real time. Such connection to the server also shortens the overall time period for viewing and ordering photographs from the event.

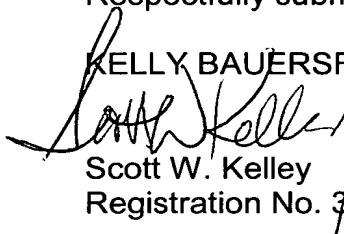
Accordingly, Applicant respectfully asserts that the recitations of claims 17, 19, 20, 35, 36, 49 and 50 are not rendered obvious by the combination of Clubphoto and the Garfinkle patent.

CONCLUSION

From the foregoing amendments and remarks, Applicant believes that claims 1, 3-5, 13, 14 and 16, as amended and new claims 51-75 are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claims 2, 21-50 have been canceled.

Claims 1, 3-5, 13, 14 and 16 have been amended as follows:

1. (Amended) A process for providing event photographs for inspection, selection and distribution via a computer network, comprising the steps of:

taking photographs of an event;

associating identifying data with each photograph taken;

informing the event participants of the identifying data;

transferring the photographs to a computer network server; [and]

cataloging the photographs in a web-site server according to the identifying data;

accessing the server and searching for a particular photograph utilizing the identifying data; and

displaying the particular photograph for inspection and ordering.

3. (Amended) The process of claim [2] 1, including the step of posting the identifying data associated with each photograph so that it is made available to the participants of the event for later use in searching the server.

4. (Amended) The process of claim [2] 1, wherein the identifying data includes a number corresponding to a number worn by an event participant.

5. (Amended) The process of claim [2] 1, wherein the identifying data comprises a code acquired from a component worn by an event participant.

13. (Amended) The process of claim [2] 1, wherein the identifying data comprises the date and time the photograph was taken.

14. (Amended) The process of claim [9] 13, wherein an approximate time can be used to search for a particular photograph.

16. (Amended) The process of claim [2]1, wherein the identifying data comprises a name of an event participant.

Add new claims 51-75 as follows:

51. A process for providing sporting event photographs for inspection, selection and distribution via a computer network, comprising the steps of:

taking photographs of a sporting event;

associating identifying data with each photograph taken, wherein the identifying data comprises the date and time when the photograph was taken during the sporting event;

informing the sporting event participants of the identifying data;

transferring the photographs to a computer network server;

cataloging the photographs in a web-site server according to the identifying data;

accessing the server and searching for a particular photograph utilizing the date and time the photograph was taken; and

displaying the particular photograph for inspection and ordering.

52. The process of claim 51, including the step of posting the identifying data associated with each photograph so that it is made available to the sporting event participants of the event for later use in searching the server.

53. The process of claim 51, wherein an approximate time can be used to search for a particular photograph.

54. The process of claim 53, wherein the approximate time is calculated using the following formula:

$$T_p = (L_p / L_c) (T_f);$$

wherein L_p equals the distance from a starting point of the event to the photographer;

wherein T_p equals the minutes from the starting point to a photographer at location L_p ;

wherein L_c equals the total distance of the event; and

wherein T_f equals the total minutes to finish the event by the participant.

55. The process of claim 51, including the step of providing a digital camera electronically connected to the server for immediate download of photographs from the event to the server.

56. The process of claim 51, including the steps of ordering a photograph of the event using the server and fulfilling the order by sending the photograph.

57. The process of claim 56, including the step of mailing the photograph utilizing information provided by the person ordering the photograph.

58. The process of claim 56, including the step of electronically transferring the photograph to the person ordering the photograph.

59. A process for providing sporting event photographs for inspection, selection and distribution via a computer network, comprising the steps of:

taking photographs of a sporting event;

associating identifying data with each photograph taken, wherein the identifying data comprises a number worn by the sporting event participant;

informing the event participants of the identifying data;

transferring the photographs to a computer network server;

cataloging the photographs in a web-site server according to the identifying data;

accessing the server and searching for a particular photograph utilizing the number worn by the sporting event participant; and

displaying the particular photograph for inspection and ordering.

60. The process of claim 59, including the step of providing a digital camera electronically connected to the server for immediate download of photographs from the event to the server.

61. The process of claim 59, including the steps of ordering a photograph of the event using the server and fulfilling the order by sending the photograph.

62. The process of claim 61, including the step of mailing the photograph utilizing information provided by the person ordering the photograph.

63. The process of claim 61, including the step of electronically transferring the photograph to the person ordering the photograph.

64. A process for providing sporting event photographs for inspection, selection and distribution via a computer network, comprising the steps of:

taking photographs of a sporting event;

associating identifying data with each photograph taken, wherein the identifying data comprises a code acquired from a component worn by the sporting event participant;

informing the event participants of the identifying data;

transferring the photographs to a computer network server;

cataloging the photographs in a web-site server according to the identifying data;

accessing the server and searching for a particular photograph utilizing the code; and

displaying the particular photograph for inspection and ordering.

65. The process of claim 64, including the step of triggering a camera to take a photograph when the component passes a predetermined point.

66. The process of claim 65, wherein the predetermined point includes a sensor which interfaces with the component.

67. The process of claim 64, wherein the component comprises a passive component.

68. The process of claim 67, wherein the component includes a bar code.

69. The process of claim 67, wherein the component includes an inductive circuit.

70. The process of claim 64, wherein the component comprises an active component.

71. The process of claim 70, wherein the active component includes an electronic device having a transmitter.

72. The process of claim 64, including the step of providing a digital camera electronically connected to the server for immediate download of photographs from the event to the server.

73. The process of claim 64, including the steps of ordering a photograph of the event using the server and fulfilling the order by sending the photograph.

74. The process of claim 73, including the step of mailing the photograph utilizing information provided by the person ordering the photograph.

75. The process of claim 73, including the step of electronically transferring the photograph to the person ordering the photograph.